UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTHA L. LYONS

Appeal 2006-2855
Application 09/774,727
Technology Center 2100

Decided: March 14, 2007

Before JOSEPH F. RUGGIERO, ALLEN R. MACDONALD, and JEAN R. HOMERE, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-20.[1] We have jurisdiction under 35 U.S.C. § 6(b).

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[1] An Appeal Brief was initially filed on Mar. 26, 2004, but prosecution was reopened. *See* Non-final Rejection filed June 28, 2004. A second Appeal Brief was later filed on July 25, 2005 and a Reply Brief filed on Nov. 30, 2005. In this opinion, we refer to the July 2005 Brief and the Nov. 2005 Reply Brief.

STATEMENT OF THE CASE

Appellant invented a centralized repository for electronically storing reputation information relating to a user in a database. The user and/or third parties (e.g., community organizations) can access the database after proper verification. Such a centralized format allows the user to transport any reputation data from one community to another. The user, however, can control the dissemination of their reputation information by preventing access to the user's reputation information unless the user authorizes releasing the information. Claim 1 is illustrative:

> 1. A reputation authority for electronically storing reputation information relating to a user comprising:
>
> a database for storing said reputation information;
>
> security measures for verifying identities of at least one of said user and a plurality of community organizations; and
>
> a communication system for receiving said reputation information and transmitting said reputation information to said plurality of community organizations responsive to an authorization received by said user.

The Examiner relies on the following prior art references to show unpatentability:

Coueignoux	US 6,092,197	July 18, 2000
Lang	US 2002/0046041 A1	Apr. 18, 2002 (filed May 10, 2001)[2]

The Examiner's rejection is as follows:

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[2] The published application claims benefit under 35 U.S.C. § 119(e) from U.S. provisional application 60/213,638, filed June 23, 2000.

Claims 1-20 are rejected under 35 U.S.C § 103(a) as unpatentable over Lang in view of Coueignoux.[3]

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

OPINION

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention set forth in the claims on appeal. Accordingly, we affirm.

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[3] Although the Examiner discusses two additional references, Schuba and Lambert, in the text of the rejection based on Lang and Coueignoux (Answer 5), the Examiner nonetheless indicates that the Schuba and Lambert references are "not part of the rejection" (Answer 5, 19). Nevertheless, Appellant presented arguments pertaining to these references (Br. 11-12; Reply Br. 6-7).

In any event, since the Schuba and Lambert references were not included in the statement of any of the rejections of the claims, they are deemed to be superfluous and therefore not before us. Consequently, we have not considered the disclosure or teachings of Schuba and Lambert in this decision. *See In re Hoch*, 428, F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("Where a reference is relied upon to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.").

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If that burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding independent claims 1, 9, and 15, the Examiner's rejection essentially finds that Lang teaches an automated system for providing reputation information with every claimed feature except for transmitting the reputation information responsive to an authorization received by the user as claimed. The Examiner cites Coueignoux as teaching this feature and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lang so that reputation information was transmitted only upon affirmative consent for publication (Answer 3-5, 7-11).

Appellant argues that Coueignoux is not analogous to the claimed invention. According to Appellant, Coueignoux pertains to communication between a sender and a user that is moderated by an agent; the user in Coueignoux must give authorization to the agent to share private information with the sender. Appellant emphasizes that the reputation authority of the claimed invention, however, is centralized, accessible by both the community organization and the user, and does not simply act as a

moderated conduit between the community organization and the user as in Coueignoux (Br. 6-8; Reply Br. 4-5).

Appellant also argues that there is no motivation to combine the references. Appellant contends, among other things, that because Lang already discusses security measures, there is no explicit suggestion that an additional security measure (i.e., requiring a party's authorization for which the reputation information is based) would be beneficial (Br. 9-11; Reply Br. 5-6). The Examiner responds that the skilled artisan would have ample suggestion to modify Lang as noted in the rejection in view of the advantages of ensuring transmission of confidential information only upon consent as suggested by Coueignoux (Answer 16-18).

We will sustain the Examiner's rejection of independent claims 1, 9, and 15. In determining whether a prior art reference constitutes analogous art, we consider "(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004).

In our view, Coueignoux is within Appellant's field of endeavor -- information retrieval. Coueignoux discloses a system that enables a sender to retrieve certain information pertaining to a user only if the user consents to publishing that information to the sender. Although an agent (i.e., the discovery and exploitation engine 14 (DEP)) essentially operates as an intermediary between the sender and the user as Appellant indicates, the user ultimately maintains control over which fact(s) are disclosed to the sender (Coueignoux, col. 18, ll. 50-60; col. 6, ll. 45-49, 59-62; col. 13, ll. 43-53).

Similarly, the claimed invention pertains to a system for enabling retrieval of information pertaining to a user's reputation only if the user consents to releasing such information. Since both the claimed invention and Coueignoux pertain to information retrieval, in particular, consent-based retrieval of information, they are in the same field of endeavor. For this reason alone, Coueignoux constitutes analogous art.

But even if we assume, without deciding, that Coueignoux is somehow not in the same field of endeavor, the reference is certainly reasonably pertinent to the inventor's problem – namely, providing an information retrieval system capable of transmitting certain information pertaining to a user to requesting parties responsive to the user's authorization. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). In our view, Coueignoux's fundamental teaching of releasing certain information requested by a sender only upon the user's consent logically would have commended itself to the inventor's attention in considering the problem of transmitting reputation information responsive to the user's authorization. For at least these reasons, Coueignoux constitutes analogous art.

We also find ample motivation on this record to combine Coueignoux's teachings with Lang. Although Lang teaches providing certain security measures (i.e., determining whether the requester is authorized to access the requested information, enabling only selected parties to access the information, etc.) (Lang, ¶¶ 0042, 0023-24; Fig. 7, Step

202), such security measures hardly foreclose providing additional consent-based security measures as suggested by Coueignoux.

Based on the collective teachings of Lang and Coueignoux, we see no reason why the skilled artisan would not have provided an additional consent-based security measure in the automated reputation service of Lang so that the user maintained at least some level of control in releasing any requested reputation information pertaining to the user. *See* Coueignoux, col. 18, ll. 50-60 (noting that the user ultimately maintains control over which fact(s) are disclosed). Requiring user consent as a condition for releasing reputation information in Lang's system would, among other things, reduce the chances of releasing inaccurate or incorrect reputation information. In our view, such a consent-based safeguard in conjunction with the other security measures in Lang would only enhance the validity and reliability of the reputation information – a stated objective of Lang. *See* Lang, ¶ 0023 (noting that safeguards may be provided for ensuring that the information upon which a reputation is based is valid and reliable). For at least these reasons, we find ample motivation on this record for the skilled artisan to combine the teachings of Coueignoux with Lang.[4]

For at least these reasons, we will sustain the Examiner's rejection of independent claims 1, 9, and 15. Since Appellant has not separately argued

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[4] Should additional prosecution follow this opinion, the Examiner should also consider credit bureaus' sharing of consumer credit information to various entities upon user consent given the broad scope of the independent claims. In this regard, a consumer's credit rating would fully meet "reputation information" as claimed. *See, e.g.,* 15 U.S.C. § 1681b(b)(2)(B)(ii) (2006) (requiring a consumer's consent "orally, in writing, or *electronically*" prior to a prospective employer procuring a consumer's credit report) (emphasis added).

the patentability of dependent claims 2-8, 10-14, and 16-20, these claims fall with the independent claims. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We have sustained the Examiner's rejection with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

ARM

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